



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,637	09/15/2003	Eadaoin Ledwidge	ICC-279	8008
31217	7590	11/07/2006		EXAMINER
LOCTITE CORPORATION 1001 TROUT BROOK CROSSING ROCKY HILL, CT 06067			SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	10/661,637	LEDWIDGE, EADAOIN
	Examiner Robert Sellers	Art Unit 1712
<i>—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —</i>		
THE REPLY FILED 31 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.		
<p>1. <input checked="" type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input type="checkbox"/> The period for reply expires _____ months from the mailing date of the final rejection.</p> <p>b) <input checked="" type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p>		
<p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>		
<p>NOTICE OF APPEAL</p> <p>2. <input type="checkbox"/> The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p>		
<p>AMENDMENTS</p> <p>3. <input checked="" type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because</p> <p>(a) <input checked="" type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input checked="" type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).</p>		
<p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____.</p> <p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> <p>7. <input checked="" type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input checked="" type="checkbox"/> will not be entered, or b) <input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> <p>The status of the claim(s) is (or will be) as follows:</p> <p>Claim(s) allowed: _____.</p> <p>Claim(s) objected to: _____.</p> <p>Claim(s) rejected: 1-20.</p> <p>Claim(s) withdrawn from consideration: 21-23 and 25.</p>		
<p>AFFIDAVIT OR OTHER EVIDENCE</p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p>		
<p>REQUEST FOR RECONSIDERATION/OTHER</p> <p>11. <input checked="" type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See the attachment.</u></p> <p>12. <input type="checkbox"/> Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____</p> <p>13. <input type="checkbox"/> Other: _____.</p>		
<p>Robert Sellers Primary Examiner Art Unit: 1712</p>		

1. The amendment after Final rejection mailed October 31, 2006 has been denied entry because the newly limited opacifying component (iii) to a lactone containing an aromatic ring fused to the lactone ring presents a new issue since it did not previously appear in any of the other claims and requires a further consideration of the species of color formers in the applied prior art. Furthermore, it is unclear whether the new structure encompasses the species of CER (CAT002, UCB) elected in the response filed April 13, 2006 (page 11, line 11) since the chemical formula, name and/or structure of the name cannot be ascertained.
2. The amendments to pages 18 and 19 of the specification would have resolved the proper identification of the cycloaliphatic resin raised in the Final rejection mailed September 1, 2006 (page 3, paragraph 3) had the amendment been entered. The denotation of the cure through volume to from at least 600-800 nm as supported on page 6, lines 14-15 and the deletion of the term "sufficient" used to qualify it would have addressed the 35 U.S.C. 112, first and second paragraphs rejections set forth on page 3, paragraph 4 and page 4, paragraph 5 of the Final rejection had the amendment been entered.
3. Montgomery et al. Publication No. 2003/013487 (page 9, Example 1, Composition C), PCT Publication No. WO 03/46042 (page 11, lines 27-28) and Japanese Patent Nos. 4-45125 and 60-72961 (CAPLUS abstracts, registry no. 1552-42-7) disclose crystal violet lactone deemed to be a suitable species of opacifying component on page 11, lines 10-12). Reardon, Jr. (col. 3, line 1 to col. 4, line 2) depicts a fluoran compound containing a phenyl group fused to a lactone.

Ren Patent No. 5,942,554 (col. 4, lines 4-24) lists the same species of lactones with fused aromatic rings as that described on page 11, lines 10-22. Grinevich et al. Patent No. 6,309797 (col. 3, line 36 to col. 4, line 31) lists species of non-lactone color formers. Japanese Patent No. 1-16802 (CAPLUS abstract, registry no. 50292-95-0) employs a species of fused aromatic ring-containing lactone espoused on page 11, lines 21-22 of the specification.

4. The claims are extremely broad and embrace any combination of a UV curable component, a UV curing initiator and an opacifying component possessing a first transparent color and a second opaque color, each of which is disclosed in each individual applied reference mentioned in the previous paragraph. It is immaterial whether the species of color formers reported in the patents are labeled the same as the claimed opacifying component since species specifically deemed to be suitable as opacifying components are identified therein.

5. The claimed cure through volume limitation is only applicable upon the application of the composition on a part, which is not a required feature. Based on the equivalent materials of a UV curable component such as a urethane acrylate (Montgomery et al.) or an epoxy compound (the remained of the applied references), a UV curing initiator and color formers specifically listed in the specification, the prior art coating formulations would inherently exhibit the claim cure through volume when applied to a part.

There is no evidence of record establishing the lack of the claimed cure through volume upon applications of the closest prior art compositions of Montgomery et al., the PCT publication, Reardon, Jr., Grinevich et al., Ren et al. and the Japanese patents to a part.

6. Grinevich et al., Ren and the Japanese patents each individually recite the claimed mixture of UV curable component of an epoxy compound, a photoinitiator and a lactone with a fused aromatic ring.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712